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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/117,795	11/10/1998	MITSUO SADO	CU-1758RJS	4079

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EXAMINER

GARRETT, DAWN L

ART UNIT PAPER NUMBER

1774

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/117,795

Applicant(s)

SADO, MITSUO

Examiner

Dawn Garrett

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004 and 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office action is responsive to the amendment dated September 28, 2004 and the remarks filed July 23, 2004. New claim 8 was added. Claims 5-7 are withdrawn. Claims 1-8 are present in the application and claims 1-4 and 8 are currently under consideration.
2. The rejection of claims 1-4 under 35 USC 112, first paragraph, set forth in the last Office action (mailed March 23, 2004), paragraph 6, is withdrawn in view of applicant's remarks.
3. Claims 1-4 and 8 are rejected under 35 USC 103(a) as obvious over JP 63-069897 A (see full English translation for citation references). Japanese patent 63-069897 describes a cleaner composition comprising 5-95 % of one or more amines of mono-, di-, and triethanol amines, 0.2-50 % of one or more high boiling point solvents comprising diethylene glycol monobutyl ether and benzyl alcohol used for removal of heavy dirt attached to hard surfaces. Instant claim 1 is drawn to "A releasing agent composition...which comprises as essential components...(A) 5 to 75% by weight of a water-soluble organic solvent represented by the formula $C_4H_9-O-(CH_2CH_2O)_nH$ where n is an integer of 2 or 3". Present claim 2 is drawn to a composition wherein (A) may be diethylene glycol monobutyl ether. JP 63-069897 clearly reads on instant component (A) by disclosing diethylene glycol monobutylether (see page 2 of translation, lines 4 and 5 of part (b)). Per the instant claim 1 requirement of 15 to 40% by weight of benzyl alcohol, JP 63-069897 also clearly discloses benzyl alcohol as a component of the composition (see page 2 of the translation, line 5 of (b)). Applicant recites an amine compound in instant claim 1 and a specific amine, alkanolamine, in instant claim 3. JP 63-069897 clearly discloses alkanolamines such as monoethanol amine, diethanol amine, and triethanol amine as part of the composition

(see page 2 of translation, line 3 of part (a)). In addition to the JP 63-069897 teaching of all components recited in instant claim 1 parts (A) – (C), the component amounts taught for the JP 63-069897 composition encompass and/or overlap with the ranges recited in instant claim 1. Applicant requires 10 to 20% by weight of an amine compound, component (C). JP 63-069897 teaches 5 to 95 parts of one or more amines (see page 2, lines 1 and 2 of part (a)), which clearly encompasses the required range of 10 to 20% by weight. Applicant requires 15 to 40% by weight of benzyl alcohol (component (B)) and 5 to 75% by weight of a water-soluble organic solvent represented by the formula $C_4H_9-O-(CH_2CH_2O)_nH$ where n is an integer of 2 or 3. JP 63-069897 teaches 0.2 to 50 parts of a combination of solvents including diethylene glycol monobutylether and benzyl alcohol (see page 2, lines 4 and 5 of part (b)). The JP 63-069897 teaching of 0.2 to 50 parts of a combination of diethylene glycol monobutylether and benzyl alcohol clearly encompasses and/or overlaps with the required amounts of 15 to 40% of benzyl alcohol and 5 to 75% by weight of a water-soluble organic solvent such as diethylene glycol monobutyl ether. Per instant claim 4, the working examples taught by JP 63-069897 describe diluting the cleaning compositions in water (see “Working Examples” page 7 of translation). It would have been obvious to one of ordinary skill in the art at the time of the invention to produce the claimed composition in the recited proportions of ingredients, since each of the claimed components in the claimed weight ranges are disclosed by JP 63-069897.

Response to Arguments

4. Applicant states “The JP reference is directed to a different art area than the present invention.” The examiner respectfully submits the preamble of claims 1-4 under consideration is drawn to “a liquid composition”. The phrase “for use in removing an aqueous polymer floor

polish” is considered to be an intended use and is not considered to be patentably significant. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regard to applicant’s argument that “the JP reference teaches that all of the high boiling solvents are equivalent to one another for the purposes of the JP invention and that only one is needed, e.g. Example 1 of the JP reference” and “the reference teaches that ethylene glycol monoethyl ether and ethylene glycol monobutyl ether are suitable solvents and such solvents are expressly excluded from the present claims”, the examiner submits JP 63-069897 does not require the composition comprise ethylene glycol mono-butyl ether, but rather recites the solvent in a Markush group as a possible solvent. The reference recites as component (b) (see second page of translation) “0.2 to 50 weights parts, and preferably 2 to 20 weight parts, of **one or more** high-boiling solvents selected from ethylene glycol monoethyl ether, diethylene glycol monoethyl ether, ethylene glycol monobutyl ether, **diethylene glycol monobutyl ether**, and **benzyl alcohol**”. The teaching clearly does not require that ethylene glycol monoethyl ether be present and accordingly, applicant’s negative limitation in claim 1 has not overcome the teaching of JP 63-069897. In addition, JP 63-069897 does not teach only one high-boiling solvent is used, but clearly teaches “one *or more* high-boiling solvents” are used. The examiner respectfully maintains all ingredients as well as amounts of ingredients of the instant claims are clearly taught by JP 63-069897 and accordingly, JP 63-069897 renders obvious the instant composition.

Applicant states "The addition of the ethylene glycol monobutyl or monoethyl ether would adversely affect the basic and novel characteristics of the present invention. The present invention clearly teaches that the ethylene glycol monobutyl ether is neither equivalent nor desirable for purposes of the present invention where maintaining floors in a generally enclosed space is the purpose." In response, the examiner maintains ethylene glycol monobutyl ether is not a required component of the JP 63-069897 composition.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (571)272-1523. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dawn Garrett
Primary Examiner
Art Unit 1774

D.G.
October 25, 2004